REMARKS

Claims 1, 3, 4, 6 to 8, 11 to 22, 24, 26 and 27 are present.

Claims 23 and 25 has been cancelled.

Claims 1, 18, 21 to 23, and 25 are rejected under 35 U.S.C. §112, first paragraph.

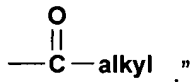
Claims 1, 14, 16, and 18 to 22 are rejected under 35 U.S.C. §103(a).

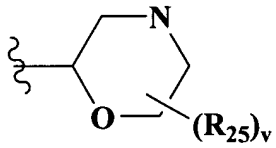
Claims 3, 4, 6 to 8, 11 to 13, 15, 24 and 26 are objected to.

Claims 17 and 27 are allowed.

Amendments

Basis for the present amendments can be found in the original claims and throughout the examples as originally filed. No new matter has been added. The scope of the claims has not been broadened by these amendments.

Claim 1 has been amended to delete the phrase "where one of R_8 and R_9 is alkyl substituted with heteroaryl and the other is cycloalkyl" and to delete the phase "where one of R_8 and R_9 is aryl and the other is  ."

In addition, the definition of W has been amended to delete  in Claims 1, 4 and 14.

Objection Under 35 U.S.C. §112, First Paragraph

Claims 1, 18, 21 to 23, and 25 are rejected under 35 U.S.C. §, first paragraph.

The Examiner contends that:

> "Particularly it is noted that examples of one or R8 or R9 is triazolyl substituted methyl and the other one is cycloalkyl, one of R8 or R9 is benzyl and the other one of R8 or R9 is n-propyl-carbonyl were found in the specification. However, no antecedent basis nor descriptive support can be found for the subgenus as '...where one of R8 and R9 is alkyl substituted with hteroaryl and the other is cycloalkyl or where one of ri and R9 is aryl and the other is C(=O)R13'. Please note that in the preferred embodiment such specific combination was not described. On pages 30-31, the preferred R8 and R9 has been delineated to be a subset of (CH_2) interpreted moieties and no particular combination for the claimed scope. Please note that an amendment to a particular combination must be supported by description and antecedent basis found in the specification. Lacking of the particular

antecedent basis of the instant claimed scope, NEW MATTER was found. Removal of all new matter is required. In re Rassemussen 211 USPQ 325."

The objected to matter in Claim 1 has been deleted.

Claims 23 and 25 have been cancelled.

The Examiner has maintained the rejection of Claims 21 and 22 under 35 U.S.C §112.

Claims 21 and 22 have been amended to include the phrase "specific disease states" set out in pages 34 to 36 of the Specification as filed. It is believed that amended Claims 21 and 22 are in compliance with 35 USC §112.

Rejections under 35 U.S.C. §103(a)

The Examiner has maintained the rejection of Claims 1-2, 4-5, 10, 14, 18 and 21-22 under 35 U.S.C. §103(a), as being obvious over U.S. 6,458,790 ("Palucki").

The Examiner contends as follows:

"Determination of the scope and content of the prior art (MPEP §2141.01)

Palucki et al. '790 disclosed melanocorin-4 receptor agonistic compounds when the 'W' moiety of the instant claims are drawn to piperazine. Structural similar compounds are found at col. 41-42 first two compounds and col. 45-46, 3rd compound of the table (not exhausted listing).

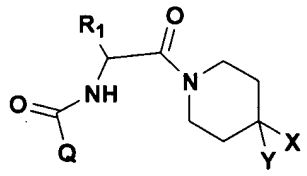
Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the Palucki et al. '790 species and the instant claims is that instead of a heteroaryl substituted alkyl for R8 or R9, the examples at col. 41-42 first two compounds and the 3rd compound of col. 45-46 have a heterocyclic substituted alkyl. Generically, Palucki et al. '790 taught that for the 'X' moiety, a heterocyclic or tiazolyl substituted alkyl are optional choices for such compounds (see col. 12 line 58 triazolylmethyl, col. 14 lines 5-10, heterocyclomethyl of compounds exemplified at col. 41-42 or 45-46) and the alternative triazolylmethyl moiety has been clearly described, enabled and exemplified at col. 70.

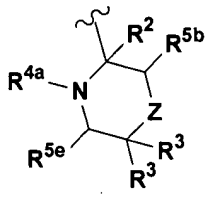
Finding of prima facie obviousness---rational and motivation (MPEP§2142-2143)

One having ordinary skill in the art would found the currently amended scope, although considered to be new matter, prima facie obvious **because** the Palucki et al. '790 not only taught generically the optional choices of structural alternatives for the 'X' moiety but also explicitly disclosed and enabled by exemplification of the preferred structure including the heteroaryl substituted alkyl for R8 while the R9 moiety is cyclohexyl. In absence of unexpected results, there is nothing unobvious in choosing some among many. In re Lemin 141 USPQ 814."

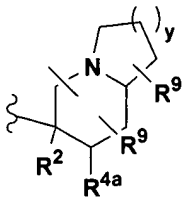
Palucki's compounds are represented by the following generic structure:



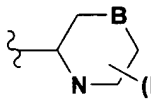
where Q is a heterocyclo ring having the specific core structure

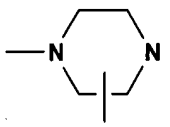


or



where Z is O, S or NR (See Palucki, column 5, lines 58-65).

Applicants have amended the claims so that W does not include  , wherein B is N, O or S.

Where Applicants' W is a piperazine, then it is 1-piperazinyl, that is  , the piperazine is linked through a nitrogen to the rest of the molecule and not a carbon as in Palucki et al. In addition, Applicants' piperazine is linked to a CH group and not a carbonyl group.

None of Applicants' amended claims contain the heterocyclo rings described by the Q variable of the Palucki compounds. Nor does Palucki describe or suggest the unexpected desirability of Applicants' claimed compounds. Palucki actually teaches away from Applicants claimed compounds as one of skill in the art would only expect desirable activity from compounds having the aforementioned Q group heterocycles. Moreover, Palucki specifies that their particularly described heterocycles be directly attached to a carbonyl. Applicants claimed compounds are substantially different from the Palucki compounds as they include a carbon linker not present in Palucki et al. and link the piperazine through a nitrogen on the ring and not a carbon as in Palucki et al. Applicants' W group does not include any heterocycle directly attached to the carbonyl. Accordingly, Applicants request withdrawal of the obviousness rejection under 35 U.S.C. §103(a) over Palucki.

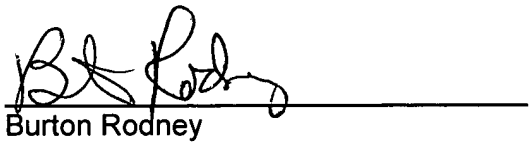
Summary

In view of the foregoing the Applicants believe that Claims 1, 3, 4, 6 to 8, 11 to 22, 24, 26 and 27, as amended, are now in condition for allowance. The Examiner is invited to contact the undersigned by telephone, at the number listed below, if it is believed that a telephonic communication would facilitate the prosecution of this application.

Fees

If it is determined that a fee is due, please charge same to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company.

Respectfully submitted,



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Date: October 21, 2004